

IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE

In the application of : MORAN, Thomas

Serial No. : 09/585,669

Filed : June 1, 2000

For : Conferencing systems with enhanced capabilities

Examiner : MILLS, Donald L.

Art Unit : 2616

Confirmation No. : 4523

Attorney Docket No. : 920673-907236

REPLY BRIEF

Honorable Director of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer of February 11, 2008, the Applicant submits the following reply brief:

Remarks

The Examiner's Answer identifies, in the section entitled "(10) Response to Argument", seven issues (numbered as Issues I to VII). Applicant wishes to make further brief comments in relation to Issues I, II, III and V.

It is submitted that nothing further needs to be added regarding Issues IV, VI and VII, as the points made in the Examiner's Answer in this regard were already sufficiently addressed and rebutted in the Appeal Brief, and the reader is referred to the Brief for those issues.

Issue I

Applicant wishes to make two brief points:

- 1) At page 13, first paragraph, final two sentences the Examiner writes:
"In addition, Beyda discloses that the telephony conference call is established utilizing convention [sic] IP telephony methods in which users may request a subconference call, these systems utilize either a traditional auditory or visual list (See column 2, lines 26-40). Therefore, the utilization of a list is implied for the establishment of a conference and subconference call."

Applicant submits that, contrary to the impression given above, the passage at column 2, lines 26-40 is completely silent on using "either a traditional auditory or visual list" as alleged.

Applicant does accept, and is happy to repeat, that a conferencing system must maintain a list of subconference users in order to manage the signals and to operate the subconference. However, just because a list is maintained and is used to manage a subconference system does not mean it is presented to the users (as the Examiner proceeds to infer).

To use the analogy given earlier, a cellular phone system will maintain a current record of the particular geographical cell in which every user is situated, and indeed this "list" is crucial to the operation of the cellular system. However, this does not

imply that the list is presented to the users in any form whatsoever, and certainly not as a graphical list with which users may interact.

2) In the immediately following paragraph, bridging pages 13 and 14, the Examiner states that in order for a user to select another user for a subconference one must ascertain knowledge of the participants in a main conference. The argument is then made that this knowledge might be “gleaned” by the user, regardless of the form of list actually presented to the user or that it may be “gained via listening”. As explained in the Appeal Brief, it is perfectly possible for users to select other users, e.g. by dialling another user’s number, without ever being explicitly or implicitly presented with a list by the conferencing system.

Anybody who has joined a telephone conference late will similarly know that it is also entirely possible to ascertain who is already in the conference by the simple expedient of verbally asking (or being told) who is already on the line. This does not in any way imply that the system has presented a graphical or auditory list of the conference participants, and it in no way makes obvious presenting a graphical, interactive user list to the participants.

Issue II

In this section, the Examiner states (page 15, lines 2-4):

“Beyda discloses a first terminal 14 transmits a subconference call request 28 to the sixth terminal 24, based on the known list of participants (See column 4, lines 33-40).”

Applicant respectfully points out that, contrary to the impression given in this quotation, the passage at column 4, lines 33-40 is wholly silent on the existence or use of a list.

In any event, the cited passage makes no teaching or suggestion of the user interacting with a graphical list to select subconference participants, so the argument on Issue II boils down to the statement that *“the claimed invention combines the well-known subconferencing system of Beyda with a well-known graphical user interface as taught in the prior art section of Beyda.”*

This would suggest that Beyda's prior art section discloses a graphical interface which would fulfil the requirements of the graphical list of claim 1, i.e. allowing users to interact with it to request a subconference with other users on the list, but in fact it discloses nothing of the sort. The prior art section notes that a conference co-ordinator may have a terminal with a display showing who is in the conference. The users in the conference have no such list and there is no suggestion that any such interface allows a user to request a subconference with another user.

Issue III

Applicant notes that the Examiner's Answer, under Issue III, is concerned exclusively with attempting to show that Beyda discloses a feature which is not in fact claimed. Thus the Examiner argues that Beyda discloses *"the list of the subset of users in the subconference is present during the text messaging between the initiator and the intended recipient during the subconference"*.

This (unclaimed) phrase relates to whether or not there exists ("is present") a list of the subset of subconferees.

Issue III is, however, concerned with an entirely different feature, namely

"presenting to said user [i.e. the user who requests the subconference] a graphical list of the subset of users in the subconference, when the subconference is in progress".

Reading the Examiner's argument on this point, it appears that it is being argued that "the subconference request message" constitutes a list containing the subset of the initiator and the recipient of that message. Regardless of whether this is true, Applicant respectfully points out that it has no bearing on the claim wording. The conclusion reached at the end of Issue III in the Examiner's Answer is, with respect, of no significance to the question of whether or not the initiator of the subconference (to use the Examiner's terminology) will be presented with a graphical list of the subset of users present in that subconference. For this reason alone, the claimed invention would not have been obvious in view of Beyda.

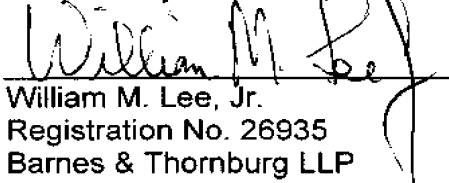
Issue V

The argument made in the Examiner's Answer, based on the prior art description of Beyda, does not disclose the users in the main conference being presented with the subconference list in any sense. The passage relied on (i) does not deal with the users in the main conference, but instead with the conference co-ordinator, and (ii) does not suggest, even for the co-ordinator, that a list is presented of the users in the subconference. In fact the opposite is true – users in the subconference are disconnected entirely from the main conference according to column 2, lines 5-8, and it seems incredible that such users would nevertheless be presented as part of a list to the users in the conference from which they have been disconnected.

It is therefore submitted that the Examiner's rejections of the application have been demonstrated to be clearly in error, and the Examiner should be reversed. Such action is therefore solicited.

April 11, 2008

Respectfully submitted,



William M. Lee, Jr.
Registration No. 26935
Barnes & Thornburg LLP
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 214-4800
(312) 759-5646 – Fax